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Mailed: January 25, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IMES Group Limited

Serial No. 75622598

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Lehrman & Zissu for IMES Group Limited.

Tonja M. Gaskins, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Quinn, Walters and Drost, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

IMES Group Limited has filed an application to register
on the Principal Register the mark WATER WEIGHTS for the
goods and services recited, as amended, below:

"load testing systems comprising load test bags,
strain gauges, stress gauges, load sensors,
shackles, non-electric cables, metal hooks,
spreader bars, load data logging and display
instruments, namely, computer hardware, computer
monitors, electric luminescent display panels," in
International Class 9; and

"services for the testing of load bearing
structures, namely, proof load testing and
certification of cranes, rigging, davits, bridges,

gantries, platforms, floors; testing of life boat systems," in International Class 42.¹

The examining attorney issued an initial refusal to register under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its goods and services. In response, applicant argued against the refusal and submitted, in the alternative, a claim of acquired distinctiveness, under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f). The examining attorney renewed the refusal on the ground of mere descriptiveness and further refused registration under Section 2(f) of the Trademark Act, stating that the mark is highly descriptive and applicant has failed to establish that the mark has acquired distinctiveness in connection with the identified goods and services.

The examining attorney issued a final refusal under Section 2(e)(1) on the ground that the mark is merely descriptive and has not acquired distinctiveness; and applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested.

¹ Serial No. 75622598, in International Classes 9 and 42, respectively, filed January 14, 1999, based on use of the mark in commerce, alleging first use and use in commerce as of 1986 in both classes. The application as filed included a basis under Section 44(e) of the Trademark Act, 15 U.S.C. 1126(e), based on U.K. Registration No. 2001072; however, applicant withdrew the Section 44(e) basis in its response of January 18, 2000.

Mere Descriptiveness

The examining attorney contends that the mark WATER WEIGHTS is merely descriptive in connection with the identified goods and services for the following reasons (Brief, p. 6, 8):

The goods(e.g., load test bags) use water weight (i.e., the water is used as weight or the weight of the water is used) to test the load bearing integrity of the load bearing structures. The services (e.g., testing of load bearing structures) feature the use of water weight (i.e., the water is used as weight or the weight of the water is used inside the bags) to test the load bearing integrity of the load bearing structures. Specifically, the applicant's inflatable load test bags use water weight instead of traditional solid weight. The water-weighted bags are used to test the load bearing integrity of several structures.

. . .

As applied to the applicant's particular goods and services, the term "WATER WEIGHTS" immediately conveys to potential purchasers that the goods and/or services feature water being used as weight. Moreover, the definition of "water" even sets forth its weight per gallon and demonstrates that water has weight and may be used by the applicant in the manner set forth by the examining attorney.

In support of her position, the examining attorney submitted dictionary definitions of "water" and "weight"; excerpts of articles retrieved from the LEXIS/NEXIS database; excerpts from applicant's Internet web site, www.waterweights.com, including third-party articles excerpted on applicant's web site; and excerpts from third-party Internet web sites.

Applicant contends that its mark is inherently distinctive for the following reasons (Brief, p. 5):

The coined phrase WATER WEIGHTS is so vague that it has no particular meaning with respect to Applicant's goods and services, and therefore cannot be considered to describe them with any one degree of particularity. This phrase suggests numerous different things, for example, weighted buoys, water wings, or other exercise equipment, special weights to be used while in a pool or other body of water, or while swimming, weights for anchoring a boat or other watercraft, etc. The mark suggests so many different meanings with respect to the goods and services covered by this application that it could only be considered fanciful or suggestive, and not descriptive for the goods and services.

The goods and services in this application have to do with load testing apparatuses and services related to testing of load bearing structures such as cranes, bridges and platforms. The goods are used, for example, to make sure a crane will not fail when in use. Along with the load test bags, the goods include various gauges, sensors, and computer equipment that are used together to test equipment and to provide associated testing services. The mark does not describe these goods or services at all. Therefore, the mark has to be considered suggestive, and not descriptive, and is therefore an ideal trademark that is registrable.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely

descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); see also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

The examining attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 21567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). With the office action of July 3, 2001, the examining attorney submitted seven excerpts of articles retrieved from the LEXIS/NEXIS database and excerpts from applicant's Internet website. All of these excerpts refer specifically to applicant and use terms other than WATER WEIGHTS to describe the identified goods, i.e., "water-

filled bags," "water bags," "water filled proof load bags."²

However, excerpts from third party Internet web sites, submitted with the February 24, 2003, office action, show use of the term "water-weight" in a descriptive manner, as shown by the following examples³:

Load testing can be accomplished in three ways: dynamometer testing, dead-weight testing, and water-weight testing. Here a lattice-boom crawler crane is being tested using water bags.

. . .

Water bags and water tanks are another means of load testing. They have the advantage of being easy to transport, to rig, and to be picked up. Because they are filled on the jobsite, water weights do not have to be transported long distances. A calibrated flow meter or load cell determines the amount of water being placed in the bag or tank. The volume of water held determines weight.

. . .

Water bags can be linked together for testing of large-capacity cranes. ...
(www.liftlink.com, February 24, 2003)

210 Ton Overhead Crane Installation, Clinton Nuclear Station a part of Mad Jack Corzine's Example of Ironworking Series ...

. . .

These cranes were lifted to the 800' level via a specially constructed lifting beam. This project also included the use of water weights by Water Weights utilizing 8 water bags for a total of 60,680 gallons of water to achieve a total test weight of 262 tons. This was a first for the nuclear industry.

² One reference to applicant stated that "Water Weights Ltd. is interested in licensing agreement (sic) with U.S. firms for the manufacture of water weight bags for proof-lead (sic) testing."

³ In view of the fact that the relevant purchasers herein are sophisticated professionals, we have considered the excerpted web sites that originate outside the United States and refer to services rendered outside the United States. See *In re Remacle*, 66 USPQ2d 1222, 1224, n. 5 (TTAB 2002).

(www.geocities.com February 24, 2003)

"Load Testing Services - Details on our load testing procedures and capabilities including both water weights and modular lead weights."

. . .

"National Crane Services offers heavy lift testing anywhere in the United States."

. . .

"Portable Weight - NCS has portable water weights up to 400 plus tons, suitable for almost all applications and configurations."

(National Crane Services, www.natlcrane.com, February 24, 2003)

In view of the nature of the identified goods and services, it is clear that, in connection with those goods and services, the connotations of both the individual terms, WATER and WEIGHTS, and the unitary term, WATER WEIGHTS, is the ordinary meaning of the terms.⁴ As applicant itself describes its product, it consists of a strong bag that is filled with water and used, individually or in groups of bags, as weight to test the load of various types of heavy equipment. While the product includes other items necessary to the use of these bags, the water bags themselves are the main aspect of the product. In fact, several of the articles and applicant's own web site focus on the

⁴ The individual terms are so common in the English language as to hardly need defining. However, for completeness, we note the definition of "water" as "a clear, colorless, odorless, and tasteless liquid, essential for most plant and animal life and the most widely used of all solvents ... weight per gallon ... 8.338 pounds ...," and of "weight" as "a measure of the heaviness of an object" and "an object used principally to exert a force by virtue of its gravitational attraction to Earth" *The American Heritage Dictionary of the English Language*, 4th ed. 2000.

advantages of using these water bags for load testing instead of concrete. Similarly, the main feature of applicant's services is the use of these water bags to conduct load testing for customers. The evidence clearly establishes that a significant aspect of applicant's goods and services are water-filled bags used as weights for testing load.

Applicant's argument that the term has many connotations, for example, in the context of pool toys or exercise equipment, is unpersuasive because, as noted above, we are bound to consider the meaning of the mark in the context of the identified goods and services. Applicant's argument that WATER WEIGHTS is not the name of the goods is similarly unpersuasive because, regardless of whether it is or is not one name for the goods, the issue before us is not genericness.

When applied to applicant's goods and services, the term WATER WEIGHTS immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods and services, as noted above. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods and services to readily perceive the merely

descriptive significance of the term WATER WEIGHTS as it pertains to applicant's goods and services.

Acquired Distinctiveness

We now consider applicant's alternative claim of acquired distinctiveness under Section 2(f) of the Act. It is applicant's burden to prove acquired distinctiveness. *Yamaha International Corporation v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954)("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." *Yamaha*, 6 USPQ2d at 1008.

However, the statute is silent as to the weight of evidence required for a showing under Section 2(f) except for the suggestion that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence.

As observed by our predecessor court, the exact kind and amount of evidence necessarily depends on the circumstances of the particular case, and Congress has chosen to leave the exact degree of proof necessary to qualify a mark for registration to the judgment of the Patent Office and the courts. In general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.

Id. (quotation marks, brackets, and citations omitted).

Applicant's evidence consists of two declarations and numerous letters from customers. The declarations include the following relevant statements of fact:

- Applicant's mark has been in substantially exclusive and continuous use in commerce since 1986;
- "Potential customers are limited to those who are in some way using and therefore testing cranes and other lifting equipment";
- "The goods are expensive (typically over \$15,000 each) and available on a limited basis through [applicant's] own network of service outlets";
- Annual sales are approximately \$15 million (presumably worldwide, in view of the sales statement below);
- Applicant's promotional and advertising efforts are aimed at those involved with lifting equipment;
- Applicant advertises in numerous industry publications, and at numerous trade shows, via the Internet; and
- In the four years preceding November 2002, in the United States applicant spent over \$400,000 on advertising and marketing, with sales of \$8.5 million.

Applicant also submitted a significant number of non-form letters from its customers attesting to their recognition of WATER WEIGHTS as the trademark of applicant for its recited

goods and services.⁵ Additionally, applicant has made it clear that its goods and services are expensive and are advertised to, and bought by, a very specific group of purchasers who are likely to be exercising great care in purchasing such goods and services.

We find that the evidence, including the long years of use, the extent of advertising and sales, the letters from purchasers, and the specific nature of the goods and purchasers, is sufficient to establish that WATER WEIGHTS has acquired distinctiveness as a mark in connection with the goods and services recited in the application.

Decision: The refusal under Section 2(e)(1) of the Act on the ground that the mark is merely descriptive is affirmed. However, the refusal under Section 2(f) of the Act on the ground that applicant's mark has not acquired distinctiveness is reversed.

⁵ While a few of the letters do not bear the signature of the person whose name is typed at the end of the letter, the letters are dated and on their respective company's letterhead and, thus, we do not doubt the authenticity of these letters.